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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,524	06/20/2001	Mark M. Lavoie	1571.2019-001	2618

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[REDACTED] EXAMINER

MILLER, WILLIAM L

ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/885,524	LAVOIE, MARK M.
	<b>Examiner</b>	<b>Art Unit</b>
	William L. Miller	3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 February 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarkisian (US#5675923).
3. Sarkisian discloses a sign comprising: a main body 12 having a first (front) surface and a second (rear) surface; a removable overlay 14 attachable to the first (front) surface in a first position; and at least two fasteners 72. The fasteners are being viewed as "movably" attached to the overlay as the fasteners are capable of being moved.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkisian in view in view of Dinan et al (US#5212898).
6. Sarkisian fails to disclose the plastic main body including hollow cells as claimed by the applicant. Dinan discloses a sign wherein a main body 11 is made of corrugated plastic, i.e. including hollow cells, thereby providing increased flexibility of the main body. Therefore, as

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taught by Dinan, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sign of Sarkisian such that the main body included hollow cells thereby providing increased flexibility of the main body.

7. Claims 1-10, 12-14, 18, 19, 22, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkisian et al. (US#5675923) in view of Cordola et al. (US#5173026).

8. Regarding claims 1, 18, 19, 22, and 32, Sarkisian fails to disclose the fasteners each passing through an oversized hole in the overlay and secured thereto via a washer whereby the washer provides spacing between the overlay and the main body upon assembly as claimed by the applicant. However, utilizing a washer as a spacing member is well known in the fastener art as Cordola discloses a fastening member 13 passing through an oversized hole 19 in panel 17 to removably attach the panel to a support 18 whereby a washer 14 provides spacing between the panel and support upon assembly. The washer thereby preventing damage to adjacent panel and support surfaces during assembly. Therefore, as taught by Cordola, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the fastening members of Sarkisian such that the fastening members passed through an oversized hole in the overlay and were secured thereto via a washer whereby the washer provided spacing between the overlay and the main body upon assembly. The washer thereby preventing damage to the overlay and main body during assembly.

9. Regarding claim 32, although Sarkisian in view of Cordola fails to specifically disclose the method as claimed by the applicant, Sarkisian in view of Cordola as discussed above discloses all the claimed sign structure required to perform the method. Therefore, it would have

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been obvious to one of ordinary skill in the art at the time the invention was made to utilize the claimed method as under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986).

10. Regarding claims 2 and 3, the main body and overlay can be plastic.
11. Regarding claim 4, the main body and overlay include a retroreflective sheeting.
12. Regarding claims 5-10, Sarkisian fails to disclose the retroreflective sheeting including glass beads, cube corner prisms, a barrier film, or adhesives as claimed by the applicant. However, as admitted by the applicant on page 5 of the specification, "any suitable sheeting used in signage can be employed". Therefore, it would have been an obvious matter of engineering design choice to modify the sign disclosed by Sarkisian by utilizing retroreflective sheeting including glass beads, cube corner prisms, a barrier film, and adhesives, since the applicant has not disclosed the specific type of retroreflective sheeting solves any stated problem or is for any particular purpose, and it appears the sign would perform equally well with any suitable sheeting.
13. Regarding claim 12, Sarkisian discloses a mounting device 20.
14. Regarding claims 13 and 14, Sarkisian discloses the fasteners as snaps which according to Fig. 7 include a shank. The shank inherently being expandable and/or deformable to function as a snap.

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15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkisian in view of Cordola, and further in view of the admitted prior art (APA).

16. Sarkisian fails to disclose the sign having a slit such that it can be folded as claimed by the applicant. However, the applicant admits on page 7 of the specification it is known to cut a sign in half (slit) and reconnect it with hinges such that the sign can be folded. Therefore, as taught by the APA, it would have been obvious to one of ordinary skill in the art to modify the sign disclosed by Sarkisian by including a slit therein such that the sign can be folded.

17. Claims 15, 16, 23-28, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkisian in view of Cordola, and further in view of Dinan et al. (US#5212898).

18. Regarding claims 15, 16, and 23, Sarkisian fails to disclose the plastic main body including hollow cells as claimed by the applicant. Dinan discloses a sign wherein a main body 11 is made of corrugated plastic, i.e. including hollow cells, thereby providing increased flexibility of the main body. Therefore, as taught by Dinan, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sign of Sarkisian such that the main body included hollow cells thereby increased flexibility of the main body.

19. Regarding claims 23-28, 30 and 31, although Sarkisian in view of Cordola, and further in view of Dinan, fails to specifically disclose the method as claimed by the applicant, Sarkisian in view of Cordola, and further in view of Dinan, as discussed above discloses all the claimed sign structure required to perform the method. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the claimed method as under

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the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986).

20. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkisian in view of Cordola, in view of Dinan, and further in view of the admitted prior art (APA).

21. As discussed previously, Sarkisian fails to disclose the sign having a slit such that it can be folded as claimed by the applicant. However, the applicant admits on page 7 of the specification it is known to cut a sign in half (slit) and reconnect it with hinges such that the sign can be folded. Therefore, as taught by the APA, it would have been obvious to one of ordinary skill in the art to modify the sign disclosed by Sarkisian by including a slit therein such that the sign can be folded.

*Response to Amendment*

22. The applicant argues Sarkisian fails to disclose the overlay being removably attachable to the first surface in a first position or the second surface in a second position. The examiner disagrees as the term "or" by definition does not require the overlay to be attachable to both the first and second surface, but rather requires the overlay to be attachable to one of the first and second surfaces. Moreover, the applicant is reminded claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). The broadest reasonable interpretation of the claims per the term "or" requires that the overlay be

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attachable to one of the first and second surfaces, not to both the first and second surfaces. In any event, if the term "or" was to be interpreted such that the overlay was attachable to both the first surface in a first position and the second surface in a second position, Sarkisian would still meet this limitation as Sarkisian discloses storage pockets for storing the overlay can be included on the second (rear) surface of the sign (col. 6, lines 45-47). Thus, the overlay would be attachable to both the first surface in a first position and the second surface in a second position.

23. The applicant argues Dinan et al. fails to teach a plurality of hollow cells within the main body. The examiner disagrees as Dinan clearly teaches the main body includes a plurality of hollow cells therein as Dinan states "sheets 11 and 12 which are fabricated from corrugated plastic (hollow with spaced internal ribs 9) material" (col. 2, lines 59-61).

24. In response to applicant's arguments against the references individually, specifically Cordola et al. failing to show an overlay removably attachable to a first surface in a first position or a second surface in a second position of the main body, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Cordola has been applied only as a teaching (modifying) reference disclosing an oversized hole and cooperating spacing washer. The base reference of Sarkisian provides the overlay removably attachable to a first surface in a first position or a second surface in a second position of the main body.

### *Conclusion*

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9326 for regular communications and 703 872 9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

William L. Miller  
Primary Examiner  
Art Unit 3677

wlm  
April 22, 2003

